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APPLICATION NO.	FILING DATE	FIRST NAME INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,291	10/15/2001	Uwe Heitmann	31653-175416	1637

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EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,291

Applicant(s)

HEITMANN ET AL.

Examiner

Dionne A. Walls

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 15-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-7 and 13-15 is/are rejected.
- 7) ☐ Claim(s) 8-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1 ☒ Certified copies of the priority documents have been received.
- 2 ☐ Certified copies of the priority documents have been received in Application No. _____.
- 3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of the Written Restriction in Paper No. 6 is acknowledged.

Specification

1. The abstract of the disclosure is objected to because its length exceeds 150 words. Correction is requested. See MPEP § 608.01(b).

Information Disclosure Statement

2. Applicant is requested to provide a Form 1449 listing all patents, publications, or other information submitted for consideration by the Office. A copy of the references were received, and the IDS was entered on October 15th, 2001, but a copy of the Form 1149 was not provided, or either was inadvertently misplaced. Another copy is requested so that the Examiner may sign/initial the sheet to show that the references have been considered.

Claim Objections

3. Claim 1 is objected to because of the following informalities: On line 13, the word "an" should be changed to – and --. Appropriate correction is requested.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, recites the limitation "the one side" in line 3, and "the other side", in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 and 13-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Adebahr et al (US. Pat. No. 4,003,385).

Adebahr et al discloses almost all that is recited in the claims, since it teaches that relatively small tobacco particles are extracted by suction from a tobacco filler stream, adhered to a forminous belt, in a cigarette making machine, and are then separated from the suction air stream for filtering, after which most of said particles are reintroduced into the tobacco stream-building zone of the machine. The filler stream embodied in the method of Adebahr can be converted into a rod-like filler ready to be draped into a web of cigarette paper to form a rod adapted to be subdivided into plain cigarettes. (Note: The Examiner interprets the "segregating step" as that point of the process where the relatively small tobacco particles get reintroduced into the filler stream, some of which, i.e. the finer fractions, would get extracted by suction once

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again, but the larger of the small tobacco particles, i.e. the coarser fractions, would be entrained by the belt along with the rest of the filler stream; see cols. 5-8 and fig. 1).

While there may be no distinct articulation of coarser and finer fractions which comprise the small tobacco particles, based on Applicant's instant specification, it appears that the term "coarser fraction" includes fragments of tobacco shreds and the term "finer fraction" includes tobacco dust and/or minute fragments. Adebahr et al discloses that the smokable material which is separated from the tobacco stream is relatively small tobacco particles (including short tobacco - which would obviously correspond to the claimed "coarser fraction" - and tobacco dust - which would obviously correspond to the claimed "finer fraction").

Regarding claim 2, Adebahr discloses that the outlet of fan 60 discharges air which contains particles of tobacco dust (i.e. finer fraction) into a relatively simple filtering unit 57 (see col. 6, lines 64-67).

Regarding claims 3-4 and 15, see fig. 1.

Allowable Subject Matter

8. Claims 8-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

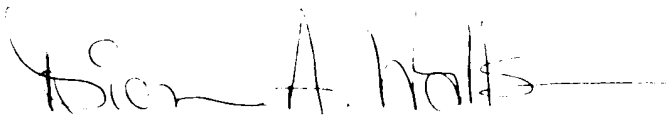
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-

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0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls", followed by a horizontal line.

Dionne A. Walls
May 15, 2003